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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/807,221

03/23/2004

Janakraj Karamchand Mehra

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06/27/2008

BLANK ROME LLP

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WASHINGTON, DC 20037

EXAMINER

BARTS, SAMUEL A

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

06/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/807,221	Applicant(s) MEHRA ET AL.	
	Examiner Samuel A. Barts	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 8-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 1/29/08, with respect to the rejection(s) of claim(s) 1-7 under 112 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Baro in view of Palmer.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baro et al (US 5,082,969) in view Palmer (US 6,252,113).

The instant claims are drawn to a process of making 1-[4-(2-methoxyethyl) - phenoxy]- 3-[(1 - methylethyl)amino]- 2- propanol by a series of steps. See claim 1. Baro discloses a process of making 1-[4-(2-methoxyethyl) -phenoxy]- 3-[(1 - methylethyl)amino]- 2- propanol by a very similar method. See columns 1-2.

Baro et al fail to explicitly teach a) the reaction step "B" at a temperature of 40-45 degrees and b) the extracting of the organic phase at a pH of 7.0-8.0 using water. Baro disclosed reaction step "B" at a temperature range of 0-30 degrees.

Palmer which is also directed to a process of making 1-[4-(2-methoxyethyl) - phenoxy]- 3-[(1 - methylethyl)amino]- 2- propanol teaches a temperature range of step

Art Unit: 1621

"B" of 50-70 degrees. Thus the art as a whole reasonably suggests that the process of Baro would work at a temperature range of 40-45 degrees. Thus it would have been obvious to one having ordinary skill in the art at the time that applicant's invention was made to have conducted the process of Baro at a temperature between 40-45 degrees with a reasonable expectation of success. One skilled in the art would have been motivated to modify the temperature in order to optimize the process

The instant claimed limitation of extracting the organic phase at a pH range of 7-8 is also deemed to be unpatentable. Please note that Baro discloses the extraction step. See for example column 1 lines 55-68 and column 2 lines 1-15. Baro is silent of the pH range of this extraction step. Baro states "after the appropriate extractions and washing...". Baro is silent of the solvent used of the pH range. However, it is reasonable to assume that water being a well known extraction solvent would produce an extraction step at a pH of 7-8. Palmer clearly shows that desire to use water as a solvent. Thus it would have been obvious at the time that applicant's invention was made to have conducted the extraction of the organic phase at a pH of 7-8. This limitation if not inherent in the process of Palmer is well within the skill of an ordinary artisan.

The examiner has carefully considered the 132 declaration alleging unexpected results and found it be unpersuasive. The alleged advantages of the instant invention are not reflected in the claims. For example, applicants allege that the instant invention avoids the using of an excess amount of isopropyl amine. This may or may not be true,

however the claimed invention reads on use of excess amount of isopropyl amine.

Applicant's claim of conducting a side-by-side comparison was found lacking.

A true side by side comparison must show that all variables are the same, including molar ratio of reactants, except for the one variable that applicants allege is responsible for unexpected results. There is no evidence of record which clearly demonstrates that applicant's claimed invention has an unexpected advantage over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel A. Barts whose telephone number is 571-272-2870. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/807,221
Art Unit: 1621

Page 5

/Samuel A Barts/
Primary Examiner
Art Unit 1621

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